



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,031	12/15/2003	Alwin Berninger	71241	4162
23872	7590	10/05/2006		
MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227				
			EXAMINER OMGBA, ESSAMA	
			ART UNIT 3726	PAPER NUMBER

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/736,031	<b>Applicant(s)</b> BERNINGER, ALWIN	
	<b>Examiner</b> Essama Omgba	<b>Art Unit</b> 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/15/03 &amp; 5/4/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of the invention of Group II, claims 13-23, in the reply filed on July 24, 2006 is acknowledged. The traversal is on the ground(s) that the method claimed, as amended, cannot be practiced by a materially different apparatus in that it does require a movable central module. This is found persuasive and as such the restriction requirement is hereby withdrawn. All claims will be examined on the merits.

### ***Claim Objections***

2. Claims 4 and 10 are objected to because of the following informalities: in claim 4, line 2, "trend" should read --trends--; and in claim 10, line 2, "in each case" should be deleted and reinserted after "freedom". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12, 23, 24 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 4, "(clamping device)" is confusing in that it is not clear whether the "articulated arms" are the "clamping device" or the "clamping device" is part of the "articulated arms". The method steps also need to be positively recited.

Claim 11 recites the limitation "the component structure" in line 2. There is insufficient antecedent basis for this limitation in the claim and as such it is not clear what the "component structure" refers to.

In claims 23 and 24, line 1 of each claim, it is not clear what the expression "the latter" refers to. The claim has been interpreted as if "the latter" refers to the "articulated arms" of the device.

Claim 28 recites the limitation "the measured values" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-10 and 12-28, *as best understood by the examiner*, are rejected under 35 U.S.C. 102(b) as being anticipated by Nagamatsu et al. (US Patent 5,438,647).

With regards to claims 1 and 13, Nagamatsu et al. discloses a method and a device for positioning components wherein a movable central module 19 has articulated arms 12A and 12B connected thereto, the articulated arms movable in space and having at least one holding element for holding the components, see column 2, lines 34-39 and 53-55. Applicant should note that the device of Nagamatsu et al. is capable of holding the components within a desired arrangement.

For claims 2 and 25, Applicant should note that the articulated arms of the device of Nagamatsu et al. could be folded and unfolded as desired.

For claims 3-5, 27 and 28, Applicant should note that such process steps and controls are old and well known in the art.

For claims 6 and 16, the device of Nagamatsu et al. could be moved out of space as claimed.

For claims 7, 15, 18 and 19, the device of Nagamatsu et al. carries a plurality of functions, see column 3, lines 51-62.

For claims 8 and 9, the arms of the device of Nagamatsu et al. could be positioned synchronously or asynchronously in space, see column 2, lines 65-68.

For claims 10 and 14, see column 3, lines 1-2.

For claims 12 and 26, see column 3, lines 63-67.

For claims 17, 20, and 22, see column 4, lines 37-43.

For claim 21, Applicant should note that robot arms with such static holding forces are old and well known in the art.

For claims 23 and 24, the arms of the device of Nagamatsu et al. could be programmed as claimed.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3726

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 11, as *best understood by the examiner*, is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagamatsu et al.

Nagamatsu et al. discloses a method for positioning components as shown above. Although Nagamatsu et al. does not disclose the clamping device directly supported on a base part of the "component structure", however it would have been obvious to one of ordinary skill in the art at the time the invention was made that having the clamping device supported on the "component structure" is an obvious matter of design choice since the clamping device could be supported on a conveyor element carrying the components, as disclosed by Nagamatsu et al., and performs efficiently.

### ***Conclusion***


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3726

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Essama Omgba  
Primary Examiner  
Art Unit 3726

eo  
September 27, 2006